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Forrest Gunnison Gunnison, McKay & Hodgson, L.L.P. 1900 Garden Road, Suite 220 Monterey, CA 93940			WONG, LESLIE	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,783

Applicant(s)

PINGEL ET AL.

Examiner

Leslie Wong

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Receipt of Applicant's Amendment, filed 22 October 2004, is acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-4, 6, 8, 10, 12-18, 20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nurse et al.** ("Nurse")(US005097418A) in view of **Amro et al.** ("**Amro**") (U.S. Patent 5,867,678).

Art Unit: 2167

Regarding claim 1, **Nurse** teaches a method of creating a reference database for a computer-readable document comprising:

a). **'entering user inputted text data for said computer-readable document in a data file'** as the present invention allows an ordinary word processing applications document to be extensively edited, including substantial resequencing of text, without the need to review all footnote/endnote insertions for the use of the correct form (col. 2, lines 18-23; col. 1, lines 41-51);

b). **'determining whether a user inputted a request to input reference data wherein said reference data characterizes a reference data source'** as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* (col. 3, lines 45-54; col. 1, lines 35-37; col. 2, lines 65 – col. 3, line 5);

c). **'entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data'** as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* once the information and source citations have. Once the information and source citations have been entered into the database, the user proceeds to invoke one or more of several format processes which have been designed Formats A, B, and C in the diagram (col. 3, lines 45-54; col. 4, lines 4-7); and

d). **'wherein said other data includes at least one citation to said user inputted reference data'** as the short form citation, for example, often includes, at a minimum, the author's last name and an abbreviation of the title (col. 3, lines 45-49; col. 4, lines 45-54; and Fig. 2).

Nurse does not explicitly teach storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file.

Amro, however, teaches **'storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file'** as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc...(col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Nurse's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized; coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Regarding claims 2, 13, 16, and 23, **Nurse** further teaches wherein the computer readable document further comprises **'a reference field for retrieving a record stored in the reference database'** as the source citation entry screen contains data entry

Art Unit: 2167

fields for record number, title of the work, a user's reference, etc... (col. 4, lines 42-54 and Fig. 2).

Regarding claims 3, 14, and 17, **Nurse** further teaches wherein the reference database further comprises:

- a). **'fields for different types of reference data sources'** as the source citation entry screen contains data entry fields for record number, title of the work, a user's reference, etc... (col. 4, lines 44-54; Fig. 2); and
- b). **'fields containing specific information associated with these different types of reference data sources'** as the user can accumulate information from several sources, which may be published works, public or private records, interview with witnesses, or a variety of other information sources (col. 3, lines 45-49; col. 4, lines 44-54; Fig. 2).

Regarding claims 4 and 18, **Nurse** further teaches wherein **'the reference database comprises a bibliographic database, and the reference data sources comprise books, journals, conference presentations, web-pages and e-mails'** as the user can accumulate information from several sources, which may be published works, public or private records, interview with witnesses, or a variety of other information sources. Source citations usually appear in one of three forms: Endnotes, which are similar to footnotes, which appear all together at the end of a *book or article*,

and embedded notes, which appear in the text immediately after the information to which they refer (col. 3, lines 1-6 and 45-49; col. 4, lines 44-54; Fig. 2).

Regarding claims 6 and 20, **Nurse** further teaches a step of **'displaying a user interactive dialogue window for inputting reference data'** as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* once the information and source citations have. Once the information and source citations have been entered into the database, the user proceeds to invoke one or more of several format processes which have been designed Formats A, B, and C in the diagram (col. 3, lines 45-54; col. 4, lines 4-7 and Fig. 2).

Regarding claim 8, **Nurse** further teaches wherein said **'method is stored as computer code in a storage medium'** the CPU 31 access addressed memory 34 which contains information that is supplied via the keyboard 33, mass storage 35, or network 36 and instructions for manipulation of that information in accordance with the operating sequences of the present invention (col. 1, lines 31-36; Fig. 1).

Regarding claim 10, **Nurse** teaches an apparatus comprising:

'a processor' as the processor 6 interacts with CPU 31 so that information can organized and formatted under control of the user (col. 1, lines 39-42; Fig. 1); and

'a storage medium coupled to said processor' the CPU 31 access addressed memory 34 which contains information that is supplied via the keyboard 33, mass storage 35, or network 36 and instructions for manipulation of that information in accordance with the operating sequences of the present invention (col. 1, lines 31-36) and;

'including a reference database for a computer-readable document, storing user inputted reference data wherein said reference data characterizes a reference data source' as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* once the information and source citations have. Once the information and source citations have been entered into the database, the user proceeds to invoke one or more of several format processes which have been designed Formats A, B, and C in the diagram (col. 3, lines 45-54; col. 4, lines 4-7)

'computer-readable document includes at least one citation to information in said reference database' as the short form citation, for example, often includes, at a minimum, the author's last name and an abbreviation of the title (col. 3, lines 45-49; col. 4, lines 45-54; and Fig. 2).

Nurse does not explicitly teach a reference database for a computer-readable document, storing user inputted reference data, together with said computer-readable document including user inputted text data in a single data file.

Amro, however, teaches **'a reference database for a computer-readable document, storing user inputted reference data, together with a said computer-readable document including user inputted text data in a single data file'** as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Nurse's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Regarding claim 12, **Nurse** teaches the a storage medium having stored thereon a computer-readable document comprising:

'a reference database storing user inputted reference data wherein said reference data characterizes a reference data source' as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* (col. 3, lines 45-54; col. 1, lines 35-37; col. 2, lines 65 – col. 3, line 5);

'wherein said other data includes at least one citation to said user inputted reference data' as the short form citation, for example, often includes, at a minimum,

Art Unit: 2167

the author's last name and an abbreviation of the title (col. 3, lines 45-49; col. 4, lines 45-54; and Fig. 2).

Nurse does not explicitly teach a storage medium having stored thereon in a single data file a computer-readable document comprising a reference database storing user inputted reference data, user inputted text data and other data of the computer-readable document.

Amro, however, teaches 'a storage medium having stored thereon in a single data file a computer-readable document comprising a database storing user inputted data, user inputted text data and other data of the computer-readable document' as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Nurse's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Regarding claim 15, **Nurse** teaches a computer program for creating a reference database for a computer-readable document, the computer program comprising program code adapted for:

a). **'entering user inputted text data for said computer-readable document in a data file'** as the present invention allows an ordinary word processing applications document to be extensively edited, including substantial resequencing of text, without the need to review all footnote/endnote insertions for the use of the correct form (col. 2, lines 18-23; col. 1, lines 41-51);

b). **'determining whether a user inputted a request to input reference data, wherein said reference data characterizes a reference data source'** as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* (col. 3, lines 45-54; col. 1, lines 35-37; col. 2, lines 65 – col. 3, line 5);

c). **'entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data'** as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* once the information and source citations have. Once the information and source citations have been entered into the database, the user proceeds to invoke one or more of several format processes which have been designed Formats A, B, and C in the diagram (col. 3, lines 45-54; col. 4, lines 4-7); and

d). **'wherein said other data includes at least one citation to said user inputted reference data'** as the short form citation, for example, often includes, at a

Art Unit: 2167

minimum, the author's last name and an abbreviation of the title (col. 3, lines 45-49; col. 4, lines 45-54; and Fig. 2).

Nurse does not explicitly teach storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file.

Amro, however, teaches '**storing the database, said user inputted text data, and other data of the computer-readable document in said data file**' as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Nurse's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Regarding claim 22, **Nurse** teaches a computer program product for creating a reference database for a computer-readable document, the computer program product comprising program code adapted for:

a). '**entering user inputted text data for said computer-readable document in a data file**' as the present invention allows an ordinary word processing applications document to be extensively edited, including substantial resequencing of

Art Unit: 2167

text, without the need to review all footnote/endnote insertions for the use of the correct form (col. 2, lines 18-23; col. 1, lines 41-51);

b). **'determining whether a user inputted a request to input reference data, wherein said reference data characterizes a reference data source'** as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* (col. 3, lines 45-54; col. 1, lines 35-37; col. 2, lines 65 – col. 3, line 5);

c). **'entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data'** as information is entered with an Editing Process which encodes the information into a suitable format and places it into a storage area of database, including the *recording of the source of that information* once the information and source citations have. Once the information and source citations have been entered into the database, the user proceeds to invoke one or more of several format processes which have been designed Formats A, B, and C in the diagram (col. 3, lines 45-54; col. 4, lines 4-7); and

d). **'wherein said other data includes at least one citation to said user inputted reference data'** as the short form citation, for example, often includes, at a minimum, the author's last name and an abbreviation of the title (col. 3, lines 45-49; col. 4, lines 45-54; and Fig. 2).

Nurse does not explicitly teach storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file.

Amro, however, teaches 'storing the database, said user inputted text data, and other data of the computer-readable document in said data file' as a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Nurse's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

4. Claims 7, 9, 11, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nurse et al.** ("Nurse")(US005097418A) in view of **Amro et al.** ("**Amro**") (U.S. Patent 5,867,678) as applied to claims 1-4, 6, 8, 10, 12-18, 20, and 22-23 above and further in view of **Mielenhausen** (U.S. Patent 6,529,911 B1).

Regarding claims 7, 21, and 24, **Nurse** and **Amro** do not explicitly teach of synchronizing the reference database with other data sources.

Mielenhausen, however, teaches a step of ‘**synchronizing the reference database with other data sources**’ as cases, statutes, legislative history, articles and other authorities can now be found at numerous web sites on the Internet, including web sites maintained by state and federal appellate courts and governmental agencies. After performing the word search, via a web site, the user can enter, organize, and analyze the results in LRO. Through LRO’s Web Sites Search Results Window, the user can view, add, edit, and delete citations obtained from the web site (col. 8, line 67 – col. 9, line 16; col. 10, lines 59-67; col. 11, lines 9-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Mielenhausen’s** teaching would have allowed **Nurse- Amro’s** to effectively help the user to work with the most recent information in order to avoid expensive and inefficient duplication of effort in organizing and analyzing the results by accompanying the status of the user’s review of the citation and the date the status was last updated as suggested from **Mielenhausen** at col. 11, lines 12-17.

Regarding claim 9, **Nurse** and **Amro** do not explicitly teach computer code is downloaded into said storage medium.

Mielenhausen, however, teaches wherein said ‘**computer code is downloaded into said storage medium**’ as through the LRO’s Paste/View Word Processor Documents List Window, the user can paste a list of document descriptions, downloaded from the user’s word processing program. The user can then add one or

Art Unit: 2167

more of those descriptions to the Word Processor Documents Search Results Window.

Further, LRO automatically saves data when user closes a window (col. 8, lines 56-65; col. 7, lines 52-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Mielenhausen's** teaching would have allowed **Nurse- Amro's** to facilitate organization, analysis, and storing of the data in the manner that is useful to the user, and to others who may want to review or use the data currently or in the future as suggested by at col. 1, lines 19-24 and col. 1, lines 29-32.

Regarding claim 11, **Nurse** and **Amro** do not explicitly teach processor is in a first device, and said storage medium is in a second device.

Mielenhausen, however, teaches wherein said 'processor is in a first device, and said storage medium is in a second device' as online databases contains the processor which resides on a first device versus the storage medium of LRO on a second device (col. 7, lines 34-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Mielenhausen's** teaching would have allowed **Nurse- Amro's** to facilitate organization, analysis, and storing of the data in the manner that is useful to the user, and to others who may want to review or use the data currently or in the future as suggested by at col. 1, lines 19-24 and col. 1, lines 29-32.

Art Unit: 2167

5. Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nurse et al.** ("Nurse")(US005097418A) in view of **Amro et al.** ("**Amro**") (U.S. Patent 5,867,678) as applied to claims 1-4, 6, 8, 10, 12-18, 20, and 22-23 above and further in view of **Lawrence et al.** ("Lawrence")(U.S. Patent 6,289,342 B1).

Regarding claims 5 and 19, **Nurse** and **Amro** teach the subject matters as discussed above.

Nurse and **Amro** do not explicitly teach wherein the reference database further comprises one field containing information about a number of citations of a reference in the document.

Lawrence, however, teaches '**the reference database further comprises one field containing information about a number of citations of a reference in the document**' as storing in Tables 2-4, the number of citations, baseline sample, and word matching etc... for the reference documents for ranking similarity of documents (col. 15, tables 2-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Lawrence's** teaching would have allowed **Nurse-Amro's** to provide ranking of papers, journal, authors, etc. by the number of citations via extracting identifies identical citations which occur in different formats, and identifies the context of citations in the body of article. Thus, the prior art facilitates locating related papers/documents which

share one or more references to enable measuring the documents similarity by context analysis as suggested by **Lawrence** at col. 18, lines 4-11.

Response to Argument

6. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

Art Unit: 2167

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie Wong
Patent Examiner
Art Unit 2167

LW
March 18, 2005